AFTER FINAL
EXPEDITED PROCEDURE

January 19, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of T. Jeary, C. Morrissey, and P. Stark
Application No. 09/744,169 Group No. 1615
Filed April 19, 2001 Examiner S. Tran
Controlled-release Selective Serotonin Reuptake Inhibitor Formulations

(Attorney Docket No. P 24,622-A USA)

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The present Request for a Pre-Appeal Brief Review is being submitted concurrently with a Notice of Appeal and follows the issuance of a final Action on August 23, 2006 (hereafter, the "final Action").

The pending claims are Claims 1, 2, 4, 5, 20, 23 to 34, 36 to 40, 45 to 51, and 55 to 66. In the Action, the Examiner repeated her rejection of the claims as being obvious over the disclosure of U.S. Patent No. 5,958,458 to Norling et al. in view of U.S. Patent No. 6,183,780 to van Balken et al. In addition, the Examiner rejected Claims 23, 24, 28 to 30, 55 to 58, and 60 to 63 under the written description requirement of Section 112, first paragraph (the

Examiner advised that the rejection was necessitated by Applicants' amendment in the previous Reply).

Applicants submit respectfully that the above rejections were in clear error. The rejections are described in further detail below.

Discussion of the Examiner's Section 103 Rejection

In the Action, the Examiner repeated her Section 103 rejection of the claims as being obvious over Norling et al. in view of van Balken et al. According to the Examiner, Norling et al. discloses a multiparticulate formulation having the release profile recited by the claims and, while Norling et al. does not disclose the use of fluvoxamine, van Balken et al. discloses the use of fluvoxamine in a delayed immediate release formulation. The Examiner argued that it would have been obvious for one skilled in the art to use fluvoxamine in the formulation of Norling et al. to obtain a multiparticulate formulation which releases fluvoxamine in the release profile specified by Applicants' claims.

The Examiner's rejection is in clear error. The Examiner bases her rejection on the assumption that the formulation of Norling et al. would present the same release profile when fluvoxamine is used. The Examiner argued that "products of identical chemical composition cannot have mutually exclusive properties" (see pages 3 and 4 of the Action) and stated that, since the same modified-release coating was used in Norling et al. as that used in Applicants' formulation, a similar release profile to that of Applicants' formulation is inherent. Applicants, respectfully, do not understand the logic of the Examiner's reasoning. The Examiner has assumed that the nature of the

coating is the only factor that determines the release profile of a formulation. She has not considered the fact that properties relating to the active agent itself affect whether the release profile is achieved.

For example, Norling et al. discloses specifically only formulations that comprise theophylline. Not only is theophylline of a different class of agents from that of fluvoxamine, it is also chemically distinct from fluvoxamine. Theophylline, also known as dimethylxanthine, is a member of the xanthane drug family, contains purine, has a molecular weight of 180.164 g/mol, and is used to treat respiratory diseases like chronic bronchitis, emphysema, or asthma. It is structurally and pharmacologically most similar to caffeine, not fluvoxamine. In contradistinction, fluvoxamine is a member of the selective serotonin reuptake inhibitors (SSRIs), containsa trifluoromethyl-substituted benzene ring with two side chains, has a molecular weight of 318.335 g/mol, and is used to treat depression, anxiety disorders and some personality disorders. Because of these chemical differences, it would be abundantly clear to one skilled in the art that fluvoxamine would not be released in the same manner as theophylline if substituted for theophylline in the same delivery formulation. In addition, while Norling et al. does suggest that anti-depressants may be used in the formulations described therein, it does not disclose or suggest the use of fluvoxamine, which is structurally different than the anti-depressants specified therein.

In view of the above, one skilled in the art, upon review of Norling et al. and van Balken et al., would still not have had an expectancy that the use of fluvoxamine (as described in van Balken et al.) in a formulation of the type described in Norling et al. would have resulted in a formulation which releases fluvoxamine in the manner specified by the claims. As such, one skilled in the

art would not have had any expectation of success and, therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

Discussion of the Examiner's Section 112 Rejection

The Examiner rejected Claims 23, 24, 28 to 30, 55 to 58, and 60 to 63 under the written description requirement of Section 112, first paragraph. The Examiner argued that the application does not provide support for the limitation "the combined amount of said ammonio methacrylate copolymer and said plasticizer in said membrane coating being in an amount of from about 4% to about 15% of the weight of the cores present in said formulation."

Applicants submit respectfully that the Examiner's rejection was made in clear error. The above range is supported in the present application in Table 5 which lists the constituents of a particular coating solution for use in a formulation of the present application as being the copolymer (Eudragit), a plasticizer (DBS), and a solvent (I.P.A.). One of skill in the art would understand that the solvent evaporates following the coating of the cores. Thus the total weight of the final coating described in Table 5 consists of the weight of the copolymer and the plasticizer. The application then goes on to state that this coating is applied to the cores at 4%, 6%, 8%, 10%, 12%, and 15%. Thus there is support for the range of about 4% to about 15%. That the percentage amounts refer to the percent of the weight of the coating compounds in relation to the weight of the cores is evident from Table 14. In "Batch 5" of the coated fluvoxamine beads listed in Table 14, the total solid weight (following evaporation of the alcohol) of the coating compounds used in the formulation (Eudragit and DBS) is 1.797 kg. This is 11.98% of the 15 kg weight of the cores used in the formulation (described therein as being a "bead"). Similarly,

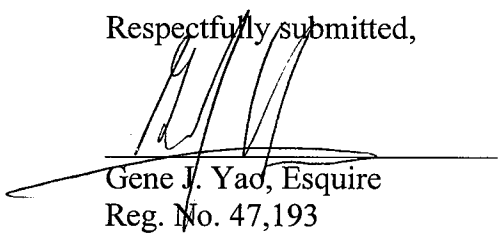
in "Batch 6" of the coated beads listed in Table 15, the total solid weight of the coating compounds used is 2.049 kg, which is 13.66% of the 15 kg weight of the cores used. Further, as shown in Table 7, formulations in which the total amount of copolymer and plasticizer is from about 4% to about 15% of the total weight of the cores exhibit the release profile recited by the claims. For example the "4%" formulation listed therein falls within the scope of Claim 23, the "8%" formulation listed therein falls within the scope of Claim 24, and the "6%" formulation listed therein falls within the scope of Claims 28 to 30.

In view of the above, there is adequate support in the application for the recitation in question.

Conclusion

In view of the above remarks, applicants submit respectfully that the Examiner's rejections were in clear error and should be withdrawn.

Respectfully submitted,



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